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REMARKS

Claims 1 through 11 and 14 through 16 are pending in the application.

Applicant acknowledges with gratitude the Examiner's indication that Claims 5, 6, 8, 9, 11 and 14 through 16 are allowable upon rewriting into independent form including all of the limitations of the base claim and any intervening claims. Accordingly, Claims 5, 6, 8, 9, 11 and 14 through 16 have been rewritten into independent form. Applicants respectfully submit that Claims 5, 6, 8, 9, 11 and 14 through 16 are now in condition for allowance.

Claim 1 has been amended to clarify that the claimed films are substantially vacuole free. Support for Claim 1 can be found in the Application as filed, for example on page 5, lines 16 through 17.

Reexamination and reconsideration of this application, withdrawal of all rejections, and formal notification of the allowability of the pending claims are earnestly solicited in light of the remarks which follow.

The Claimed Invention is Patentable in Light of the Art of Record

Claims 1 through 4, 7 and 10 are rejected over United States Patent No. 5,935,903 to Goss et al (US 903) in view United States Patent No. 5,900, 294 to Murschall et al. (US 294).

It may be useful to consider the invention as recited in the claims before addressing the merits of the rejection. The claims are directed to white films having a thickness of from 10 to 500 μm formed from a crystallizable polyolefin-free

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thermoplastic polyester polymer which is substantially vacuole-free, at least one titanium dioxide of the rutile type that is oxidatively coated, and at least one optical brightener. The titanium dioxide and the optical brightener are incorporated into the claimed films in the form of at least one masterbatch.

Surprisingly, the recited coated, rutile titanium dioxide avoids the occurrence of vacuoles within the polymer matrix during film production. The substantially vacuole-free films of the invention are altogether unexpected in light of conventional wisdom, which teaches that titanium dioxide produces voids within polyester films. (The Examiners attention is kindly directed to the primary reference, US 903 at Col. 4, lines 28 – 35, noting titanium dioxide as a void former within polyester film).

The recited films exhibit an advantageous combination of good optical properties, i.e. a high level of whiteness in combination with a low Yellowness index. More specifically, the synergistic action of the recited titanium dioxide, optical brightener and masterbatch technology gives the film a whiteness of at least 85%, combined with a Yellowness Index of 40 or less, as reflected in allowed Claim 9.

The films of the invention are suitable for use in a wide variety of applications, including interior decoration, exhibition stands and displays.

The cited references, both directed to particular voided film constructions, do not teach or suggest the claimed invention.

US 903 is directed to voided thermal transfer printing receiver sheets. (Col. 1, lines 4 – 6). The sheet contains a mixture of small voids, formed by inorganic filler particles, and large voids, formed by organic filler particles. (Col. 1, lines 55 – 65). Titanium dioxide is noted to be a void forming inorganic filler. (Col. 3, lines 24 – 33;

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Col. 3, lines 60 - 62 and Col. 4, lines 28 - 35). The necessity of the voids within the films of US 903 is evidenced by the reference in the specification that a particular void characteristic, i.e. size distribution, is an "important parameter." (Col. 3, lines 46 - 47).

US 903 does not teach or suggest the recited substantially vacuole-free films of the invention, and particularly not the vacuole-free films of the invention that further include titanium dioxide. US 903 actually teaches away from the recited films by emphasizing the importance of vacuoles to the invention and expressly noting titanium oxide as a void former.

Accordingly, Applicants respectfully submit that the claimed invention is patentable in light of US 903, considered either alone or in combination with the art.

The secondary reference does not cure the deficiencies within the primary reference. US 294 is generally directed to heat sealable packaging films formed from polyolefin. (Col. 1, lines 10 - 12 and 65 - 67). The polyolefin films include a base layer containing a propylene polymer and at least one outer layer containing an olefinic resin composition. (Col. 2, lines 1 - 8). US 294 discloses a laundry list of fillers for inclusion within the polyolefin film, including titanium oxide. (Col. 3, lines 20 - 30). The incorporation of filler into the base layer is expressly noted to form vacuoles within the base layer. (Col. 4, lines 23 - 25). US 294 provides a further laundry list of additional additives for incorporation into the polyolefin film, including lubricants and the like. (Col. 5, lines 47 - 52). US 294 is silent as to the use of optical brighteners, however.

US 294 similarly does not teach or suggest the recited substantially vacuole-free films of the invention, and particularly not such films containing titanium dioxide. In fact, US 294 also teaches away from such films by expressly noting the formation of vacuoles in conjunction with inorganic fillers. US 294 further does not teach or suggest the recited polyester films, much less polyester films containing a combination of titanium dioxide and optical brightener.

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Consequently, Applicants respectfully submit that the claimed invention is patentable in light of US 294, considered either alone or in combination with the art of record.

There would have been no motivation to have combined US 903 and US 294. US 903 is directed to thermal transfer printing sheets. US 294 is directed to heat sealable films. Both of these films are in altogether different fields of endeavour from the present invention, primarily directed to films used in interior decoration, exhibition stands and displays.

Applicants further respectfully submit that merely because the references can be combined is not enough, there must still be a suggestion. MPEP 2143.01 (section citing Mills). Applicants respectfully submit that the Office Action is indulging in impermissible hindsight by merely picking and choosing elements from the prior art while using the instant specification as the guide for that selection process.

However, even if combined (which Applicants submit they did not do), the recited substantially vacuole-free film would not result. US 903 is directed to voided thermal transfer printing receiver sheets that contain a mixture of various sized voids. US 294 discloses heat sealable polyolefin packaging films that similarly contain voids. Consequently, even if combined, the recited film formed from crystallizable polyolefin-free thermoplastic polyester polymer that is substantially vacuole-free would not result.

Accordingly, Applicants respectfully submit that Claims 1 through 11 and 14 through 16 are patentable in light of US 903 and US 294, considered either alone or in combination.

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Remarks Directed to Particular Claim Limitations

The Office Action notes on Page 3 that 'a crystallizable polyolefin-free thermoplastic polyester polymer' is not a positive limitation. Applicants respectfully submit that negative claim limitations are now permitted, so long as the boundaries of the protection sought are set forth definitely. MPEP 2173.05 (i). Applicants further respectfully submit that the phrase "polyolefin-free" clearly defines polyester polymer compositions that exclude polyolefins, and is thus is thus a permitted limitation.

Conclusion

It is respectfully submitted that Applicants have made a significant and important contribution to the art, which is neither disclosed nor suggested in the art. It is believed that all of pending Claims 1 through 11 and 14 through 16 are now in condition for immediate allowance. It is requested that the Examiner telephone the undersigned if any questions remain to expedite examination of this application.

It is not believed that fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional fees are necessary to allow consideration of this paper, the fees are hereby authorized to be charged to Deposit Account No. 50-2193.

Respectfully submitted,



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